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EXAMINER

MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 07/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/725,667

Applicant(s)

FELLMAN, BARRY

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-24 and 26-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 26-31, 34-37, and 39-43 is/are rejected.
- 7) ☒ Claim(s) 32, 33 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOV POPOVICI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission filed on 10-May-2004 has been entered. In addition, the "After Final" amendment filed on 19-April-2004 has been entered for the continued examination of this application.

### ***Remarks***

2. In response to the After Final amendment filed on 19-April-2004, the specification of the disclosure has been amended by the applicant to overcome to objections made in the previous Office Action. In addition, claims 25 and 44 have been canceled, and claims 23, 24, and 43 have been amended per applicant's request. Therefore, claims 19-24, and 26-43 are presently pending in the application.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 19-24 and 26-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 (in lines 11-14), and claim 26 (in lines 13-17), recite the limitation of selecting “one or more” available names, and continue with the recitation of registration of “multiple” domain names, which renders the claim vague. Since the “one or more” is presented in the alternative form, the user’s selection of “one” available name, contradicts with the registration of “multiple” or a “plurality” of domain names. Appropriate corrections are required.

Claim 34 (in lines 11-13), recites the limitation of request to register “one or more” available names, and continues with the recitation of registration of “multiple” domain names, which renders the claim vague. Since the “one or more” is presented in the alternative form, the user’s request to register “one” available name, contradicts with the registration of “multiple” or a “plurality” of domain names. Appropriate corrections are required.

Claims 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being dependents from the rejected independent claim 19.

Claims 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being dependents from the rejected independent claim 26.

Claims 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being dependents from the rejected independent claim 34.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-20, 22-24, 26-28, 30-31, 34-36, 39-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (U.S. Patent No. 6,519,589) in view of Broadhurst (U.S. Patent No. 6,560,634), and further in view of Ryan (U.S. Patent No. 6,412,014.)

As to claim 19, Mann et al teaches a method of facilitating availability checking and registration of domain names (see Abstract), the method comprising:

providing an electronic form (see figure 5A) for allowing a user to specify a plurality of names (see figure 5A, block 504) to be checked for availability in a domain name registry database (see column 5, lines 54-66, and see column 6, line 66 through column 7, line 26);

receiving a set of names specified by the user from the form, the set of names comprising a plurality of names to be checked (see Abstract; see column 2, lines 55-56; and see column 7, lines 10-26);

querying a registry database (see column 2, lines 58-63, where “querying a data source” is taught; and see column 5, lines 61-66) to check an availability of each of the plurality of names with each of a plurality (see column 6, lines 11-17), of Top Level Domain (TLD) extensions (see column 7, lines 18-26, and see column 8, lines 56-63); and

generating and returning to the user a query results display (see figure 5D) showing the availability of each name in conjunction with each of the plurality of TLD extensions (see figure 5D, block 514), to formulate a registration request (see figure 5D, where the “Register Now” hyperlinks, when clicked on by the user, will form a request to register the domain name) to register a plurality of domain names.

Mann et al does not teach the query results display including a table; wherein the table is presented in conjunction with a user option to select one or more available name-TLD extension combinations (“domain names”); and whereby the user can formulate a single request to register a plurality of domain names.

Broadhurst teaches a method of determining availability of Internet domain names (see Abstract), in which he teaches the query results display including a table (see figure 6A); wherein the table is presented in conjunction with a user option to select one or more available name-TLD extension combinations [“domain names”] (see figure 6A, column 610, and see column 3, lines 25-37, where the format of the query any of a number of forms such as “check boxes” in a graphical user interface); and whereby the user can formulate a single request to register a plurality of domain names (see figures 6A and 6C; see column 2, lines 41-52, and see column 7, lines 12-

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26, where it is obvious that the user can use the single request form, figure 6A, to register a plurality of domain names, figure 6C.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al to include the query results display including a table; wherein the table is presented in conjunction with a user option to select one or more available name-TLD extension combinations ("domain names"); and whereby the user can formulate a single request to register a plurality of domain names.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al by the teachings of Broadhurst because including the query results display including a table; wherein the table is presented in conjunction with a user option to select one or more available name-TLD extension combinations ("domain names"); and whereby the user can formulate a single request to register a plurality of domain names, would enable the user to select the domain name(s) of choice from the displayed list of available domain names and form a request to register the desired domain name.

In addition to the above combination, Ryan teaches an Internet directory (see Abstract), in which he teaches registering a plurality of domain names (see column 3, lines 52-63, and see column 6, lines 28-39.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, to include registering a plurality of domain names.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, by the teaching of Ryan, because registering a plurality of domain names, would allow the user to avoid repetitive process of searching for, and registering domain names one at a time, by registering a primary domain name, resulting in a plurality of registered domain names available under various top-level-domains, as taught by Ryan (see column 3, lines 52-56.)

As to claims 20, 28, and 41, Mann et al as modified teaches wherein the user option to select one or more available domain names comprises selection check boxes provided within the table, such that a separate check box is provided for each available domain name (see Broadhurst, figure 6A, column 610, and see column 3, lines 25-37, where the format of the query any of a number of forms such as “check boxes” in a graphical user interface.)

As to claims 22, 27, and 40, Mann et al as modified teaches wherein the plurality of TLD extensions are predefined, such that the method is performed without requiring the user to specify each of the plurality of TLD extensions (see Mann et al, column 4, lines 16-23.)

As to claim 23, Mann et al as modified teaches wherein the form permits the user to specify the plurality of names by entering text strings from which the plurality of names are to be derived (see Mann et al, figure 5A, block 504, and see column 7,



lines 22-26), and the method further comprises using a database of information about frequencies of term usage to derive variations of an entered test string to suggest to the user (see Mann et al, figures 5A, 5C, and 5D, where in figure 5A, the user entered the string “tax” for his domain name, figure 5C informed the user that he/she would get a list of available domain names featuring his selected string, and figure 5D displays the “derived variations” of the entered string “tax”, as suggestions to the user, also see column 1, line 63 through column 2, line 4, and see column 5, lines 22-30.)

As to claim 24, Mann et al as modified teaches wherein the form includes a single text window which is suitable for user entry, and concurrent submission, of the plurality names (see Broadhurst, figure 5B, where the user can submit multiple text entries “within the same user session”).

As to claim 26, Mann et al teaches a method of checking the availability of domain names for registration (see Abstract), the method comprising:

providing a web form (see figure 5A) allowing a user to specify multiple names to be queried for availability (see figure 5A, block 504) such that the user need not specify associated Top Level Domain (TLD) extensions (see column 4, lines 16-23);

receiving a submission comprising multiple names entered by the user into the web form (see Abstract; see column 2, lines 55-56; and see column 7, lines 10-26);

For the remaining steps of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.

As to claim 30, Mann et al as modified teaches further comprising providing the user an option to specify a plurality of name servers to be associated with each domain name to be registered (see Broadhurst, column 2, lines 41-52, and see column 3, line 66 through column 4, line 15.)

As to claim 31, Mann et al as modified teaches further comprising receiving a single submission from the user (see Broadhurst, figure 5B) specifying multiple domain names to be registered, and submitting the multiple domain names for registration (see Broadhurst, figure 6A, and see Ryan, column 3, lines 52-63, and see column 6, lines 28-39.)

As to claim 34, Mann et al teaches a system for allowing a user to query a database to determine the availability of multiple names for domain name registration, the system comprising:

a web page adapted for user entry and submission of a set of names (see figure 5A) to be checked for domain name registration availability (see Abstract, and see column 2, lines 49-62), wherein the web page allows a user to submit multiple names at a time (applicant is directed to the remarks and discussions made in claim 19 above); and

a server which is responsive to submission from the web page (see column 3, line 66 through column 4, line 8) of a set of multiple names (see column 7, lines 22-26) by at least (a) determining registration availability of each of the names in combination

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with each of a set of multiple Top Level Domain (TLD) extensions (see column 2, lines 49-62), such that the user need not specify the TLD extensions (see column 4, lines 16-23), and (b) generating a query results display indicating, for each combination of a name and a TLD extension, whether the combination is available for registration, wherein the query results display provides a user option to generate a request to register one or more of the combinations that are available, such that the user may request registration of multiple domain names in a single request (applicant is directed to the remarks and discussions made in claim 19 above.)

As to claim 35, Mann et al as modified teaches wherein the query results display comprises a query results table (see Broadhurst, figure 6A.)

As to claim 36, Mann et al as modified teaches wherein the query results table includes means for selecting one or more available domain names for registration (see Mann et al, figure 5D, and see Broadhurst, figure 6A.)

As to claim 39, Mann et al teaches method of displaying information on the availability of multiple names for registration as domain names (see Abstract, and see figure 5D), the method comprising:

For the remaining steps of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.)

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As to claim 43, Mann et al teaches a method of checking domain name registration availability (see Abstract), the method comprising:

displaying a view allowing a user to specify a name to be queried for availability (see figure 5A) as a Second Level Domain (SLD) in a domain name registry database (see column 8, lines 4-30);

receiving from the user the name to be queried for availability as the SLD (see column 8, lines 26-27);

looking up an availability status of the name in combination with each of multiple Top Level Domain (TLD) extensions not specified by the user (see column 8, lines 30-32); and

displaying query results for the name in a table (the applicant is directed to the remarks and discussions made in claim 19 above) showing the availability of the name as a SLD in conjunction with each TLD extension (see column 8, lines 57-67);

wherein the table is displayed within a web form that permits the user to select multiple domain names from the table and to submit, from said web form, a request to register the multiple domain names, such that multiple domain names may be registered concurrently (for the teachings of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.)

7. Claims 21, 29, 37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (U.S. Patent No. 6,519,589) in view of Broadhurst (U.S. Patent No. 6,560,634), and further in view of Ryan (U.S. Patent No. 6,412,014), as applied to

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claims 19-20, 22-28, 30-31, 34-36, 39-41, and 43-44 above, and further in view of Chang et al (U.S. Patent No. 6,539,370.)

As to claims 21, 29, 37, and 42, Mann et al as modified teaches the table includes a separate row for each of the plurality of names (see Mann et al, figure 5D, and see Broadhurst, figure 6A.)

Mann et al as modified still does not teach the table includes a separate column for each of the plurality of TLD extensions.

Chang et al teaches a report generating and viewing method (see Abstract), in which she teaches the table includes a separate column for each of the plurality of TLD extensions (see figures 4, 4A, and 7; see column 4, lines 29-54, and see column 5, lines 26-37.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, to include a separate column for each of the plurality of TLD extensions in the table.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, by the teaching of Chang et al, because a separate column for each of the plurality of TLD extensions would offer the user all the available domain names under each domain name extension in a single view in order for the user to be able to select the desired domain names and extensions for registration.

*Allowable Subject Matter*

8. Claims 32, 33, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, Mann et al (U.S. Patent No. 6,519,589), Broadhurst (U.S. Patent No. 6,560,634), Ryan (U.S. Patent No. 6,412,014), and Chang et al (U.S. Patent No. 6,539,370), do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

after submission of the multiple domain names for registration, generating a display which includes a second table indicating, for each of the multiple domain names, whether registration was successful, as claimed in claim 32.

Claim 33 are objected to as being dependent from the objected to dependent claim 32.

The prior art of record, Mann et al (U.S. Patent No. 6,519,589), Broadhurst (U.S. Patent No. 6,560,634), Ryan (U.S. Patent No. 6,412,014), and Chang et al (U.S. Patent No. 6,539,370), do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

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wherein the server is responsive to a request to register multiple domain names by generating a web page that includes a table indicating, for each of the multiple domain names, whether registration was successful, as claimed in claim 38.

*Response to Arguments*

10. Applicant's arguments filed on 19-April-2004 with respect to the rejected claims in view of the cited references have been fully considered:

In response to applicant's arguments regarding the examiner's stance on the submitted 37 CFR 1.131 Affidavit, and in view of the remarks presented in the Supplemental Declaration under 37 CFR 1.131, the arguments and remarks have been fully considered but are not deemed persuasive, because:

(a). According to the MPEP, "a general allegation that the invention was completed prior to the date of the reference is not sufficient". The affidavit or declaration and exhibits "must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b)." (see MPEP, § 715.07, GENERAL REQUIREMENTS.)

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(b). In general, “proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose” (see MPEP, § 715.07, THREE WAYS TO SHOW PRIOR INVENTION.) The screen-shots submitted by the applicant, only represent the “front-end” of the invention. In the absence of the “dated, underlying code”, the examiner cannot establish, via the screen-shots alone, that the invention “actually existed and worked for its intended purpose” at the time of the claimed reduction to practice.

In view of the above requirements set forth by the MPEP, the examiner is maintaining the validity of the references cited in the previous and the present Office Actions as appropriate “prior art” to the claims of the present invention.

In response to the applicant’s arguments regarding independent claims 19, 26, 34, and 39, the arguments have been fully considered but are not found persuasive, because Broadhurst teaches the user having the option of selecting one available domain name and submitting a single request to register the one domain name by clicking on the “REGISTER NOW” button (see figure 6A). Since the above claims recite the user’s selection of domain names in the alternative format of “one or more” (claim 39 further recites the registration of “one or more” available domain names), Broadhurst’s teaching satisfies the limitations of these claims. Additionally, it is obvious that the user can use the “single” request form taught by Broadhurst, to register multiple or a plurality of domain names, by registering one domain name and returning to the same (single) form to register another domain name. The applicant’s attention is also called to Broadhurst’s figure 6C, where the purchase form has an



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area, offering a "Multiple Names Allowed" option, which indicates that Broadhurst supports registering "multiple domain names".

In response to the applicant's argument regarding claim 43, the argument has been fully considered but is not found persuasive. For the selection of "multiple domain names" and registering "multiple domain names", the applicant is directed to the remarks and discussions made in response to the arguments made for claims 19, 26, 34, and 39 above. Further, in view of the "concurrent" registration of domain names, while Broadhurst does not directly indicate that multiple domain names can be registered "simultaneously", "concurrent" registration of multiple domain names in Broadhurst's invention is interpreted in the user's ability to register multiple domain names, although one at a time, but within the "same user session".


### *Conclusion*

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

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July 2, 2004



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